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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,630	08/02/2006	Kin Fai Kam	KAM 0101 PUSA	4213
22045	7590	02/16/2011	EXAMINER	
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			CLINE, SALLY COLSON	
ART UNIT	PAPER NUMBER			
	3765			
MAIL DATE	DELIVERY MODE			
02/16/2011	PAPER			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/597,630	KAM, KIN FAI
	<b>Examiner</b>	Art Unit
	Sally Colson Cline	3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 08 January 2010.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-5,8-16 and 19-24 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5,8-16 and 19-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 02 August 2006 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office Action is in response to the interview of 04 May 2010, in which it was determined that the final Office Action of 8/11/2009 was erroneously recorded in PAIRS as being non-final. This Office Action is a final rejection of the amendments filed on 01/08/2010.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the resistive hinge (claim 22) and more than one support member (claim 24) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new matter is "the support members are configured to resist lateral movement of the spectacles."

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 5 recites the limitation "the connection point" in line 2. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 12 recites the limitation "the end portion" in line 2. There is insufficient antecedent basis for this limitation in the claim. For the purpose of examination, "the end portion" is being treated as --the free end--.

***Claim Rejections - 35 USC § 102***

9. Claims 1, 3-5, 8-12, 16, 20, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferrara (USPN 7,013,491).

As to claim 1, Ferrara discloses headwear (1) to be supported directly on a wearer's head with a portion that projects beyond the circumference of the head above the eyes (2), support members (4) connected to the projecting portion (2) and having a free end (14) for detachable connection to the temple arms (3) of a pair of spectacles.

It is noted that the support members (4) project beyond a circumference of a wearer's head, because they are attached to the cap which is on the exterior of a head, and are attached at a location that is above the eyes of the wearer. Furthermore, this is an intended use recitation in which the wearer is required to wear the cap with the bill facing forward, and it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ F.2d 1647 (1987).

The functional recitation that the support members provide lifting action and reduce pressure on a nose has not been given patentable weight because it is narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth 35 U.S.C. 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

However, even though this recitation is not given weight, it is found that the Ferrara reference meets the limitation. When the support members 4 are attached to the temples of eyeglasses 13, then the eyeglasses are supported by the cap in addition to the head, as opposed to when a user is wearing eyeglasses that are solely supported by the head. Thus, pressure exerted on a nose is shared by the cap and the wearer's head, which reduced the pressure on the nose. Even if the support members also pull the eyeglasses backwards, which is asserted by Applicant in the Remarks, they are still additionally pulling upwards, which will pull the eyeglasses upwardly and off the nose.

As to claim 3, Ferrara discloses the support members are adjustable for length ("retractable cord," col 3 line 9).

As to claim 4, Ferrara discloses the support members are adjustable by bending. The cord is bendable because it bends around the reel 11 in order to be retracted.

As to claim 5, Ferrara discloses the support members are adjusted (length-wise) at the connection point (7).

As to claim 8, Ferrara discloses the ends of the support members are configured to be foldable (because they are rubber and capable of being folded) against the projecting portion when the free ends of the support members are not attached to the temple arms.

Note that claim 8 has not further defined the structure of the invention. Claim 8 is reliant on intended use ("while the wearer is wearing the headwear," "when the free ends of the support members are not attached to the temple arms") and functional recitations ("configured to be foldable," which only requires the capability to fold, and

since all materials have an inherent flexibility, all materials are foldable. Therefore, any material meets this claim limitation of being foldable.)

As to claim 9, Ferrara discloses the support members are constituted by a single piece (4) attached to the projecting portion (11) and having free ends (8) for connection to the temple arms (13) of a pair of spectacles.

As to claim 10, Ferrara discloses the support members are two separate elements (4, 9).

As to claim 11, Ferrara discloses the free end (8) is formed as a hook for connection to the temple arms (13).

As to claim 12, Ferrara discloses the free ends of the support members are flexible (rubber) so as to be formable into the hook.

As to claim 16, Ferrara discloses catch elements (retractable reel 11) provided in the projecting portion such that while the wearer is wearing the headwear, the support members can be held adjacent to the projecting portion when not attached to the temple arms.

Note that "can be" is not a positive recitation, and has not provided structure to the claimed invention.

With regard to the recitation, "while the wearer is wearing the headwear," this is an intended use recitation.

As to claim 20, Ferrara discloses strings 4.

As to claim 24, Ferrara discloses more than one support member (fig 1).

***Claim Rejections - 35 USC § 102***

10. Claims 1-2, 19, 21, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Feldman (USPN 2,691,164).

As to claim 1, Feldman discloses headwear (10) with a projecting portion (14), support members (48) with free ends (42) for detachable connection to temple arms (36) of a pair of spectacles, the support members providing a lifting action support temple arms and reducing pressure exerted on the nose.

As to claim 2, Feldman discloses the rods are flexible, because they are formed from the flexible material brass, other metal, or plastic (col 3 line 28).

As to claim 19, Feldman discloses the support members are formed as rods.

As to claim 21, Feldman discloses the support members are configured to resist lateral movement of the spectacles, to the degree that lateral movement of the spectacles is limited to the length of the support members.

As to claim 22, Feldman discloses the support members connect to the projecting portion with a resistive hinge (58).

***Claim Rejections - 35 USC § 103***

11. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrara.

As to claims 13-15, Ferrara discloses the invention substantially as claimed, but does not expressly disclose magnets. However, it is well known in the art that various types of fastening mechanisms are functionally equivalent. Hooks, snaps, magnets, and adhesive are a few examples. These fasteners may be used interchangeably

depending upon the desired aesthetic effect. Further, the specification does not give an indication of why the magnet would be desirable over another fastener type.

***Response to Arguments***

12. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sally Colson Cline whose telephone number is (571)272-6731. The examiner can normally be reached on M - F, 9AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on 571-272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sally Colson Cline  
Examiner  
Art Unit 3765

Scc

/KATHERINE MORAN/  
Primary Examiner, Art Unit 3765